

ESTTA Tracking number: **ESTTA1466**

Filing date: **06/12/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	CSL Silicones Inc.		
Entity	Corporation	Citizenship	Canada
Address	144 Woodlawn Road West Guelph, ONT N1H 1B5 CANADA		

Attorney information	John A. Clifford Merchant & Gould P.C. PO Box 2910 Minneapolis, MN 55402 UNITED STATES jclifford@merchantgould.com, aavery@merchantgould.com, dockmpls@merchantgould.com Phone:612.336.4616
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### Applicant Information

Application No	85758631	Publication date	06/04/2013
Opposition Filing Date	06/12/2013	Opposition Period Ends	07/04/2013
Applicant	Midsun Group, Inc. 135 Redstone Street Southington, CT 06489 UNITED STATES		

### Goods/Services Affected by Opposition

Class 017. First Use: 2001/02/14 First Use In Commerce: 2001/02/14  
All goods and services in the class are opposed, namely: SILICON RUBBER COATING MATERIAL FOR APPLICATION TO ELECTRICAL EQUIPMENT FOR PROTECTION AGAINST ELECTRICAL FAILURE

### Grounds for Opposition

Immoral or scandalous matter	Trademark Act section 2(a)
Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

### Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85764584	Application Date	10/26/2012
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	570
Design Mark	
Description of Mark	NONE
Goods/Services	Class 002. First use: First Use: 1991/12/31 First Use In Commerce: 1991/12/31 silicone based coating for application to electrical insulators

Attachments	2013 06 12 Notice of Opposition.PDF(227687 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John A. Clifford/
Name	John A. Clifford
Date	06/12/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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 CSL Silicones Inc.,

Opposer,

v.

Midsun Group, Inc.,

 Applicant.
 

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Opposition No. \_\_\_\_\_

Serial No.: 85/758631

 Mark: **570**

**NOTICE OF OPPOSITION**

To The Assistant Commissioner for  
Trademarks  
ATTN: BOX TTAB  
2900 Crystal Drive  
Arlington, VA 22202-3513

Dear Sir:

CSL Silicones Inc., a corporation duly organized and existing under the laws of Canada, with a mailing address of 144 Woodlawn Road West, Guelph, Ontario N1H 1B5 Canada, believes that it will be damaged by the registration of the 570 mark shown in Application Serial No. 85/758,631, filed October 19, 2012 by Midsun Group, Inc., with a mailing address of 135 Redstone Street, Southington, Connecticut 06489, and hereby opposes registration of the mark. The grounds for opposition are as follows:

1. By the application herein opposed, Applicant is seeking to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the trademark 570 for:

International Class 17: Silicon rubber coating material for application to electrical equipment for protection against electrical failure.

This application (Serial No. 85/758,631) is based on Applicant's use of the mark in commerce since February 14, 2001.

2. Applicant's Mark published for opposition on June 4, 2013. Notice of Opposition is timely filed.

3. Opposer is the owner of the following U.S. Trademark Application:

**570**, Application No. 85/764584, used in connection with silicone based coating for application to electrical insulators, in International Class 2. Said application was filed on October 26, 2012 with a first use date of December 31, 1991, which is a date prior to the date of Applicant's first use date.

4. Opposer has sold its **570** electrical insulator coating in the United States since at least 1991. Opposer's product is a single component leakage current and flash over prevention coating that has been formulated for high voltage insulators. Opposer's product is closely related to the silicone rubber coating material for application to electrical equipment for protection against electrical failure allegedly sold by the Applicant. Opposer's mark has been advertised and promoted extensively during the last 22 years, and having achieved a broad base of commercial and applications successes within North America and Internationally, and over which time it has been used by Opposer such that the mark is well-known in the industry and with customers, potential customers and industry specific, application specification influencers.

5. On February 27, 2013 Opposer's U.S. Trademark Application 85/764,584 was provisionally refused on the basis of a potential likelihood of confusion by the United States Patent and Trademark Office. The basis for this refusal was Applicant's Application Serial No. 85/758,631. In rejecting Opposer's application, the United States Patent and Trademark Office stated that "if the mark in the referenced application

registers, [Opposer's] mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks”.

6. Since at least as early as December 31, 1991, Opposer has used the 570 mark in the United States. Said use has been continuous since the date of first use and has not been abandoned.
7. Opposer has advertised and promoted its 570 mark. Opposer has also made substantial sales under said mark. As a result of such use and promotion, Opposer's 570 mark has developed and represents valuable goodwill inuring to the benefit of Opposer.
8. Opposer has priority of use with respect to the mark at issue in this opposition. Opposer has had priority of use of the 570 mark long before the February 14, 2001 first use date of the mark alleged in Applicant's application.
9. Applicant is well aware of Opposer and Opposer's prior use of the 570 mark. In fact, Applicant served as a reseller of Opposer's 570 product in the United States. Because of that relationship, which came to an end in 1999, Applicant had actual knowledge that Opposer was the owner of the 570 mark well prior to the alleged first use date in the application herein opposed of February 14, 2001.
10. On or about October 19, 2012, Joseph R. Carvalko signed what has become trademark application Serial No. 85/758,631 with a declaration that stated that Mr. Carvalko was authorized to execute the application and that he believed the Applicant to be the owner of the trademark sought to be registered, that he believed the Applicant was entitled to use the mark in commerce, and that to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce. That declaration was incorrect and false.

11. Applicant was at least as early as 1999 aware that Opposer, and not Applicant, was the owner of the 570 mark for coating materials for application to electrical equipment. Applicant should not be granted a registration resulting from this application because the declaration was materially false
12. Applicant's 570 mark is confusingly similar to Opposer's 570 mark. The marks are identical and have an overall confusingly similar appearance, sound, meaning and commercial impression. Applicant's goods are highly and closely related to Opposer's goods.
13. Applicant's mark is deceptively similar to Opposer's mark. The marks have a confusingly similar appearance, sound, meaning and commercial impression. Consumers will mistakenly believe that Applicant's goods are offered by, affiliated with and/or sponsored by Opposer when the same is not true.
14. Due to the highly similar nature of Applicant's mark and Opposer's mark, the closely related nature of the goods provided by the respective parties, consumers and potential consumers are likely to believe that Applicant's goods originate from Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.
15. The use and registration by Applicant of the mark 570 for Applicant's goods are likely to cause confusion or to cause mistake or deception among consumers and potential consumers, with Opposer's previously used 570 mark, again resulting in damage to Opposer.
16. Because of the highly related nature of the goods, and the highly similar nature of the marks in overall appearance, sound, meaning and commercial impression, use and registration of the term 570 by Applicant is likely to cause confusion, mistake, or

deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer causing further damage to Opposer.

17. If Applicant is granted registration of the mark herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its alleged mark. Such registration would be a source of further damage and injury to Opposer and would bar Opposer from obtaining its own registration for the 570 mark.

18. This application should be refused registration because at the time of filing, Application knew that Opposer, and not Applicant was the owner of the 570 mark, and the declaration filed with the application is materially false.

19. Registration of the mark shown in Application Serial No. 85/758,631 will result in damage to Opposer under the provisions of §2(a), and §2(d) of the U.S. Trademark Act, 15 U.S.C. § 1052 pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that the registration of the proposed mark 570 set forth therein be refused. Please direct all correspondence to the attention of:

John A. Clifford  
Merchant & Gould P.C.  
P.O. Box 2910  
Minneapolis, MN 55402-0910  
Tel: 612-336-4616 Fax: 612-332-9081

Opposer hereby appoints: John A. Clifford; Danielle I. Mattessich; Heather Kliebenstein, Brian H. Batzli; Gregory C. Golla; Scott W. Johnston; Andrew S. Ehard; Christopher J. Schulte; and Brent Routman as its attorneys with the full power to represent the Opposer in connection with this proceeding.

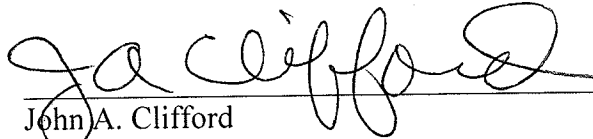
Respectfully submitted,

CSL Silicones Inc.,

By its attorneys,

Date:

June 12, 2013

A handwritten signature in black ink, appearing to read "John A. Clifford", written over a horizontal line.

John A. Clifford

MERCHANT & GOULD P.C.

P.O. Box 2910

Minneapolis, MN 55402-0910

Tel. 612.336.4616

Fax 612.332.9081

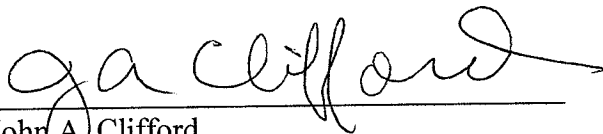
JAC/aja



**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** was served, via first-class mail, postage prepaid on the below this 12<sup>th</sup> day of June 2013.

Joseph R Carvalko  
LAW OFFICES OF JOSEPH R CARVALKO, JR  
50 Beach Ave  
Milford, CT 06460-8155

  
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John A. Clifford